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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,606	09/10/2001	Robert Seseck	10012530-1	8271

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EXAMINER

THEIN, MARIA TERESA T

ART UNIT PAPER NUMBER

3627

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/954,606

**Applicant(s)**

SESEK, ROBERT

**Examiner**

Marissa Thein

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                                                |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4-21-2003</u> . | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on April 21, 2003 is being considered by the examiner.

### ***Drawings***

The drawings filed on September 10, 2001 are acceptable.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. The claimed invention must utilize technology in a non-trivial manner. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow

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apply, involve, use, or advance the technological arts. There is no structural or functional interrelationship with these method steps. Therefore, the claim is nothing more than an abstract idea, which is not tied to any technological art and is not a useful art. *Ex parte Bowman*, 61 USPQ2d 1665, 1671 (BD, Pats. App. & Inter. 2001). See MPEP 2106 IV 2(b). For example claim 1 can be rewritten as, "A computerized method for conducting ....."; and "receiving an order from a database....", etc.

Claims 10-16 are rejected under 35 U.S.C. 101 because it fails to recite **computer executable** instructions. The claims are directed to machine-**readable**. Giving the term its broadest reasonable interpretation, the claims are directed to a program per-se and a program instruction. Accordingly, the claim fails to recite a positive functional interrelationship between the medium and the activities recited. Please refer to MPEP 2106.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The recitation "the act of shipping" lacks proper antecedent basis.

Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The recitation "the tag" lacks proper antecedent basis.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-23 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S.**

**Patent No. 5,426,281 to Abecassis.**

Regarding claims 1, 10, and 17, Abecassis discloses a method, computer program product, and system for payment of delivered goods comprising: receiving an order to deliver a good (once the transaction has occurred and the time of delivery has arrived col. 4, lines 17-18; col. 3, lines 12-14); receiving authorization to request payment from an account (verification communications equipment .....the equipment includes a point of sales credit authorization col. 5, lines 29-40); generating a ticket (verified receipt or slip, col. 4, lines 16-17) containing information relating to the authorization (see at least col. 4, lines 14-17; col. 12, lines 18-24); delivering the ordered good (see at least col. 3, lines 12-14; col. 7, lines 57-60); reading the ticket (deposit slip requires confirmation of delivery prior to payment col. 12, lines 59-62); request payment upon delivery from the account (obtain actual delivery confirmation prior to payment of the deposit to the seller, col. 10, lines 5-6; the confirmation of the buyer's acceptance of delivery may be required before the deposit is paid to the seller

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by the payment system, col. 7, lines 57-60); and a delivery device operable device (col. 7, lines 46-50)

Regarding claims 2-5, 7-9, 11-16, and 18-23, Abecassis discloses receiving authorization to charge the account and requesting payment comprising charging account (charge/debit transaction system; col. 3, lines 57-59); placing a hold on the account (place a hold on the deposit account, col. 10, liens 31-32; col. 11, lines 12-13); draw funds on the account (charge/debit transaction system; col. 3, lines 57-59; col. 7, lines 9-10); release of the good online if the request for payment is approved or verified (Figure 5); readable information representing buyer and good data (Figure 10); recording a recipient's physical location to verify that the good as been delivered to a correct address ( the buyer's acceptance of delivery required before the deposit is paid to the seller, col. 7, liens 57-60); and determining a delivery time (delivery by date (203) Figure 2); calculating a purchase price according to delivery time and requesting payment in the amount of the calculated price (the delivery by date condition is entered by the buyer for the successful completion of the transaction can be performed, col. 8, lines 18-24; col. 8, lines 30-33); registration of the delivered goods according to the buyer and goods data (Figure 2); interfaces operable facilitate electronic communication between n the delivery device and one or more other devices (Figure 1B).

Regarding claim 6, Abecassis disclose the act of shipping comprise generating a ticket to be associated with the good (see at least Figure 6; col. 4, lines 16-17), the ticket having readable information representing payment data (Deposit No., Figure 6); and the act of request payment comprises reading the ticket upon delivery (deposit slip

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requires confirmation of delivery prior to payment col. 12, lines 59-62) and request payment according to the payment information (see at least col. 7, lines 9-10).

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,703,344 to Bezy et al. discloses a real-time point transaction funds confirmation system.

U.S. Patent No. 5,761,648 to Golden et al. discloses a data processing system issuing electronic certification, which includes transaction data and identification data. The certificate can be used for various purposes such as proof of a payment.

U.S. Patent No. 5,903,875 to Kohara discloses method of issuing a service ticket in transaction of commodities.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 703-308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot  
November 14, 2004

*Michael Cuff* 11/15/04  
**MICHAEL CUFF**  
**PRIMARY EXAMINER**